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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,650	01/16/2004	James E. Manuel	016295.1559 (DC-05989)	8070
23640	7590	04/18/2005	EXAMINER	
BAKER BOTTS, LLP 910 LOUISIANA HOUSTON, TX 77002-4995			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 04/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/759,650

Applicant(s)

MANUEL, JAMES E.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/25/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gale (GB 2 246 115 A).

Regarding claim 1, Gale discloses a breakaway packing system with a packing support **14** and detachable joint **25 & 26**. Gale is capable of functioning as claimed.

As to claim 2, the joint of Gale is reusable.

As to claim 3, Gale discloses foam (Page 6, lines 2-4).

As to claim 5, the claim is a product-by-process claim. However, Gale discloses die cutting (Page 3, last paragraph).

As to claim 6, Gale discloses a dovetail joint (see Figures 3 and 6).

As to claim 7, Gale is capable of functioning as claimed.

2. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morris (US 6,488,153).

Regarding claim 1, Morris discloses a breakaway packing system with a packing support **12** and detachable joint **3, 5, & 15**. Morris is capable of functioning as claimed.

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As to claim 2, the joint of Morris is reusable.

As to claim 3, Morris discloses foam (Col. 2, lines 54-55).

As to claim 5, the claim is a product-by-process claim. However, Morris discloses die cutting (Col. 3, lines 14-16).

As to claim 6, Morris discloses a dovetail joint (see Figures 1-6).

As to claim 7, Morris is capable of functioning as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Gale (GB 2 246 115 A) or Morris (US 6,488,153).

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Claim 4 is a product-by-process claim. Both Gale and Morris, as applied to claim 1 above, disclose the claimed product. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

4. Claims 8-10 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figure 1 of the instant application (hereinafter PA1) in view of Kurick (US 4,287,990).

Regarding claim 8, PA1 discloses a computer system 9, and a detachable container support 4 & 6. PA1 merely lacks the description of the components of the computer system and a detachable joint in the container support.

The examiner takes Official Notice that computer systems with a printed circuit board, processor, memory, and chassis arranged as claimed were common and conventional at the time the invention was made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a computer system of the type claimed by the applicant in a package as disclosed in PA1 in order to securely deliver the system to a consumer.

Applicant, of course, has the right to challenge this Official Notice in response to this decision and demand production of evidence in support thereof, provided such challenge is accompanied by adequate information or argument that, on its face,

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creates a reasonable doubt regarding the circumstances justifying the Official Notice.

See In Re Boon, 439 F.2d 724, 169 USPQ 231, 234 (CCPA 1971).

As to the detachable joint, Kurick discloses a shipping package with a detachable joint **37 & 38**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container support of PA1 with a detachable joint as taught by Kurick in order to secure the container support portions together.

As to claim 9, Kurick discloses a reusable joint.

As to claim 10, PA1 discloses a foam packing support (page 3, lines 22-23 of the instant application).

Claims 12 and 14 are product-by-process claims. PA1-Kurick, as applied to claim 8 above, discloses the claimed product. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

As to claim 13, PA1-Kurick is capable of functioning as claimed.

Regarding claim 15, PA1-Kurick discloses the claimed method (page 3, lines 21-28), with separation of the detachable joints being inherent in the combination.

As to claim 16, PA1 discloses joining the packing support and Kurick discloses reuse.

As to claim 17, PA1-Kurick discloses the claimed invention except for the placing the packing support over a portion of the chassis in an automated process. It would

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have been obvious to one of ordinary skill in the art at the time the invention was made to assemble the package in an automated process in order to reduce manpower involved in assembly. It has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

As to claim 18, PA1 discloses foam.

5. Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over PA1-Kurick as applied to claims 8 and 15 above, and further in view of Hauss (US 3,511,990).

PA1-Kurick discloses the claimed invention except that PA1-Kurick uses a pin and socket joint instead of a dovetail joint. Hauss shows that a dovetail joint was an equivalent structure known in the art. Therefore, because these two joining means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the dovetail joint of Hauss for the pin and socket of PA1-Kurick.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over PA1-Kurick as applied to claim 15 above, and further in view of Morris (US 6,488,153).

PA1-Kurick merely lacks the express disclosure of forming the packing support using a die-cutting process. PA1-Kurick is silent on the method of forming the packing support.

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Morris discloses that die-cutting was a means of forming a packing support known in the art at the time the invention was made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the packing support of PA1-Kurick using a die-cutting method in order to shape the packing support as desired.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
7 April 2005


Mickey Yu
Supervisory Patent Examiner
Group 3700